

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed July 2, 2003. Claims 1, 2, and 4-9 were pending in the present application. By this amendment, claim 1 has been amended to more clearly define the claimed invention. Support for the amended method claim can be found in the specification at *inter alia* pages 18 to 21. No new matter has been added. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Claims 1, 2, and 4-9 are currently under consideration. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 1-2, and 4-9 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

The Examiner objects to independent claim 1 which recited a step comprising "selecting a putative compound which is found to inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product," because the compounds disclosed in Table 1, page 18 "were not previously known" to exhibit these properties. (Office Action of 7/2/2003, page 2; emphasis original). Claims 2 and 4-9 depend from independent claim 1. Applicants acknowledge that in the examples in the Specification (pages 18 to 21) the Egr-1 antisense oligonucleotides were tested for their ability to inhibit Egr-1 protein synthesis *after* they were assessed for their ability to inhibit smooth muscle cell proliferation. However, Applicants submit that the order in which the steps are carried out is not essential.

The Specification clearly describes a method of screening a compound involving the combination of (i) assessing the ability of a putative compound to inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product, and (ii) assessing the ability of the putative compound to inhibit proliferation of cells. The Specification at page 9, line 17 to page 10, line 6 makes it clear that the putative agent/compound

(i.e., an agent/compound that inhibits the induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product) does not need to have been previously assessed for inhibition of proliferation of cells.

In response, Applicants amend independent claim 1 to specify a method of screening for compounds which inhibit proliferation of vascular and neoplasia cells comprising: (a) assessing the ability of the putative compound to inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product; (b) assessing the ability of the putative compound to inhibit proliferation of cells selected from the group consisting of vascular cells and neoplasia cells; and (c) *selecting a putative compound that has been found to inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product and inhibit proliferation of cells* selected from the group consisting of vascular cells and neoplasia cells." (emphasis added)

Independent claim 1, as amended, specifies a method requiring the screening of a compound which can inhibit proliferation of vascular or neoplasia cells by the ability of the compound to also inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product. The method, as claimed in amended independent claim 1, does not require that the ability of the putative compound to inhibit induction of Egr-1, decrease expression of Egr-1 or decrease the nuclear accumulation or activity of the Egr-1 gene product to have been "previously known," which was the grounds for rejection by the Examiner. Applicants submit that independent claim 1, as amended, specifies a method that is described in the Specification and is not directed to any new matter.

Further, the Applicants submit that the cited art does not teach or suggest a method of screening a compound that involves the combination of steps (a), (b) and (c) as specified in amended claim 1. Claims 2 and 4-9 depend from independent claim 1. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 112, ¶ 1 be withdrawn.


CONCLUSION

In light of the amendments and arguments set forth above, Applicants earnestly believe that they are entitled to a letters patent and respectfully request the Examiner to expedite prosecution of this patent application to issuance. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant(s) petition(s) for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. (529282000220).

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Respectfully submitted,

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